

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

NIPPON SHINYAKU CO., LTD.,)	
)	
Plaintiff,)	
)	
v.)	
)	
SAREPTA THERAPEUTICS, INC.,)	
)	
Defendant.)	C.A. No. 21-1015 (MN)
<hr/>		
SAREPTA THERAPEUTICS, INC.,)	
)	
Defendant and Counter-Plaintiff,)	
)	
v.)	
)	
NIPPON SHINYAKU CO., LTD. and NS)	
PHARMA, INC.,)	
)	
Plaintiff and Counter-Defendants.)	
<hr/>		

ORDER

At Wilmington this 16th day of May 2022:

WHEREAS, on July 13, 2021,¹ Plaintiff, Nippon Shinyaku Co., Ltd (“Nippon Shinyaku” or “Plaintiff”) filed a motion for a preliminary injunction, seeking an order requiring Defendant, Sarepta Therapeutics, Inc. (“Sarepta”), “to within five (5) days . . . withdraw its previously-filed petitions for *inter partes* review (‘IPR’) of U.S. Patent Nos. 9,708,361; 10,385,092; 10,407,461; 10,487,106; 10,647,741; 10,662,217; and 10,683,322” and ordering Sarepta to “take no further action in the IPR proceedings aside from effectuating withdrawal of the aforementioned petitions” (D.I. 4-1);

¹ This case was reassigned from the Honorable Leonard P. Stark to the undersigned on March 11, 2022.

WHEREAS, after Plaintiff's motion was denied (D.I. 47), Plaintiff appealed (D.I. 55);

WHEREAS, on appeal, the Federal Circuit "conclude[d] that Nippon Shinyaku has shown that all four preliminary injunction factors weigh in its favor," "reverse[d] the decision of the district court" and "remand[ed] for entry of a preliminary injunction" (D.I. 92-1 at 16);

WHEREAS, the parties cannot agree on the form of injunction, specifically whether the Court should require Sarepta to withdraw its IPR petitions or allow Sarepta to request to stay its participation in the IPR proceedings while it contemplates appeal to the Supreme Court (D.I. 110); and


WHEREAS, the Court disagrees with Sarepta that the Federal Circuit was unclear about the scope of the injunction to be entered on remand, particularly because the scope of the proposed injunction sought was evident to the Federal Circuit (*see* D.I. 92-1 at 4 (noting that Plaintiff filed a motion "asking the court to enjoin Sarepta from proceeding with its IPR petitions and to require that Sarepta withdraw the petitions"))).

THEREFORE, IT IS HEREBY ORDERED that:

1. Nippon Shinyaku's Motion for Preliminary Injunction (D.I. 4) is GRANTED.
2. Sarepta Therapeutics, Inc. ("Sarepta") shall withdraw its previously-filed IPR petitions for U.S. Patent Nos. 9,708,361; 10,385,092; 10,407,461; 10,487,106; 10,647,741; 10,662,217; and 10,683,322.
3. Within five (5) days of this Order, to effectuate withdrawal of the IPR petitions, the parties shall jointly submit an email to the Patent Trial and Appeal Board ("PTAB") requesting a conference call to facilitate the withdrawal of the IPR petitions by requesting leave to file motions to terminate the IPR petitions. If the PTAB grants leave to file the motions to terminate the IPR

petitions, Sarepta shall move to terminate the IPR petitions according to the schedule set by the PTAB.

4. Sarepta shall take no further action in the IPR proceedings aside from effectuating withdrawal of the aforementioned petitions.²


The Honorable Maryellen Noreika
United States District Judge

² At this time, the Court declines to include in its order Plaintiff's request to include an evidentiary ruling regarding reference to or reliance upon the IPR proceedings during this litigation. That request was not included in Plaintiff's original motion or proposed injunction and appears to be premature.